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| 10/645,722 | 08/20/2003 | Kenneth Algiene | 020375-038110US | 8172 |
| 20350 | 7590 | 11/23/2009 | EXAMINER | |
| TOWNSEND AND TOWNSEND AND CREW, LLP | | | PRESTON, JOHN O | |
| TWO EMBARCADERO CENTER | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/645,722 | ALGIENE ET AL. | |
| | Examiner | Art Unit | |
| | JOHN O. PRESTON | 3691 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 27 April 2009.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3-17 and 19-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3-17 and 19-24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on August 22, 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

1. Claims 1, 3-17, and 19-24 were presented for examination. Applicant filed an amendment on April 27, 2009. Claims 22-24 were added. No claims were canceled. Claims 1, 4-6, 9, 10, 13-17, and 20 were amended. After careful consideration of applicant's arguments/amendments, the examiner maintains the grounds of rejection for claims 1, 3-17, and 19-21. The examiner establishes new grounds of rejection for claims 22-24. Since the new grounds of rejection were necessitated by applicant's amendment of the claim(s), the rejection of claims 1, 3-17, and 19-24 is a final rejection of the claim(s).

Response to Arguments

2. Applicant argued that the prior art does not disclose, teach, or suggest redemption categories or allocating a balance among categories. Examiner respectfully disagrees. Chien teaches a system wherein a consumer has a choice of redeeming loyalty points in more than one category, which is analogous to the redemption categories of the claimed invention (Chien: pg 8-13). Chien also suggests allocating a balance of the consumer's loyalty points among one or more categories (Chien: pgh 52), which is analogous to allocating a balance among categories. Therefore Examiner finds Applicant's argument nonpersuasive.
3. Applicant argued that the prior art does not disclose, teach, or suggest the limitation of multiplying the portion of the elective balance by the bid premium. Examiner respectfully disagrees. Chien teaches a conversion ratio used by merchants to determine the currency value of the loyalty points used to purchase a good (Chien: pgh 13), which is analogous to multiplying the portion of the elective balance by the bid premium. Therefore Examiner finds Applicant's argument nonpersuasive.
4. Applicant argued that claims 3-17 and 19-24 are allowable based on the allowability of claim 1. For the reasons stated above, claim 1 is not allowable. Therefore, Examiner finds Applicant argument nonpersuasive.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 9-13 and 23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 9-13 and 23, as best understood, it appears that the claimed method steps could simply be performed by mental process alone and are not statutory. Based on Supreme Court precedent, a proper process must be tied to a machine or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the machine to which it is tied, for example by identifying the machine that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Claim 9-13 and 23 are directed towards steps of calculating, receiving, and providing. Since the claims are directed to a process without including a machine (i.e. machine, manufacture, or composition of matter), these claims fall within the scope of human intelligence alone, and are non-statutory.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. Claims 1 and 3-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chien (US 2001/0054003 A1) and in view of Ghouri (US 2002/0082978 A1) and further in view of Official Notice.

Claim 1: Chien suggests the following limitation(s):

- *a microprocessor based device communicably coupled to a communication network;* (See at least Chien: page 4, pgh 33)
- *a computer readable medium associated with the microprocessor based device,* (See at least Chien: pg 4, pgh 33) *wherein the computer readable medium includes instructions executable by the microprocessor based device to:*
- *receive a request for a first interface from a bid device;* (See at least Chien: pg 2, pgh 13)
- *serve the first interface to the bid device across the communication network,* *wherein the first interface is operable to receive a first input;* (Chien, page 2, paragraph 13)
- *receive a request for a second interface from a redemption device;* (Chien, page 6, paragraph 49: the system and method refers to a computer used as a redemption device);
- *serve the second interface to the redemption device across the communication network,* *wherein the second interface in part presents to a holder of an elective account balance the first input and wherein the second interface is operable to*

receive a second input, wherein the second input is received from the holder of an elective account balance; (Chien, page 7, paragraphs 50-51: participant connects to website through a communication network);

- *allocate at least a portion of an elective balance to a particular one of a plurality of available redemption categories [[y]] based at least in part on the second input; (Chien, page 1, paragraph 8; page 7, paragraph 52)*
- *calculate a redemption amount by multiplying the portion of the elective balance by the first input, wherein the redemption amount is of a same unit of measurement as the elective balance; (Chien, page 7, paragraph 52)*

Chien does not explicitly teach the limitations below. However, Ghouri further suggests:

- *wherein the first input is a bid premium from one of a plurality of entities competing for access to the elective balance through bid premiums on the redemption categories (Ghouri: pg 2, pgh 22; pg 3, pgh 50; pg 5, pg 65-69)*

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elements cited in Chien with the elements as taught by Ghouri because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. Chien/Ghouri does not disclose the remaining limitation:

- *wherein the redemption amount is of a same unit of measurement as the elective balance.*

However, the Examiner takes **Official Notice** that it is old and well known in the business arts to provide a redemption amount that is of a same unit of measurement as the elective balance. For example, a rebate offered by a retailer in the same currency used to purchase a product (e.g. cash rebate of \$50 off if you buy a set of 4 tires at \$95 a tire) is a common practice of providing a redemption amount that is of a same unit of measurement as the elective balance. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elements cited in

Chien/Ghouri with the prior art as taught by Official Notice because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately.

To adequately traverse the examiner's assertion of Official Notice, the Applicant must specifically point out the supposed errors in the Examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. A general allegation that the claims define a patentable invention without any reference to the Examiner's assertion of Official Notice would be inadequate. Support for the Applicant's assertion should be included.

Claim 3: Chien/Ghouri/Official Notice suggests the limitation(s) as shown in the rejection of claim

1. Chien further suggests the following:

- *receive a request for a third interface; (Chien, page 7, paragraph 52)*
- *serve the third interface to the redemption device, wherein the third interface is operable to receive a third input; (Chien, page 7, paragraph 54)*
- *deduct an amount corresponding to the third input from the redemption amount, (Chien, page 7, paragraph 54)*
- *reduce the elective balance by an amount corresponding to the third input divided by the first input. (Chien, page 7, paragraph 52)*

Claim 4: Chien/Ghouri/Official Notice suggests the limitation(s) as shown in the rejection of claim

1. Chien further suggests the following:

- *the particular redemption category is selected from a group consisting of: cash, a retail outlet, vacation time, additional sick days, and a service provider. (Chien, page 6, paragraph 50)*

Claim 5: Chien/Ghouri/Official Notice suggests the limitation(s) as shown in the rejection of claim

1. Chien further suggests the following limitation:

- *receive a request for a third interface from a second bid device (Chien, page 2, paragraph 13);*

- *serve the third interface to the second bid device across the communication network, wherein the third interface is operable to receive a third input* (Chien, page 2, paragraph 13);
- *allocate a second portion of the elective balance to a second redemption category based at least in part on the fourth input* (Chien, page 7, paragraph 52); and
- *calculate a second redemption amount by multiplying the second portion of the elective balance by the third input* (Chien, page 7, paragraph 52).

Claim 6: Chien/Ghouri/Official Notice suggests the limitation(s) as shown in the rejection of claim

1. Chien further suggests the following:

- *allocate a remaining portion of the elective balance to a second redemption category* (Chien, page 7, paragraph 52).

Claim 7: Chien/Ghouri/Official Notice suggests the limitation(s) as shown in the rejection of claim

6. Chien further suggests the following:

- *the first redemption category is selected from a group consisting of: a retail outlet, vacation time, additional sick days, and a service provider* (Chien, page 6, paragraph 50).

Claim 8: Chien/Ghouri/Official Notice suggests the limitation(s) as shown in the rejection of claim

7. Chien further suggests the following:

- *a second redemption category is cash.* (Chien, page 2, paragraph 15).

9. Claims 9-17 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chien (US 2001/0054003 A1) and in view of Ghouri (US 2002/0082978 A1).

Claim 9: Chien suggests the following limitation(s):

- *providing a first interface to a bid device across a communication network;* (Chien, page 2, paragraph 13);
- *receiving a bid premium via the first interface;* (Chien, page 2, paragraph 13);

- *providing a second interface to a redemption device, wherein the second interface in part presents the bid premium to a holder of an elective account balance; (Chien, page 7, paragraphs 50-51: participant connects to website through a network);*
- *calculating a redemption amount by multiplying the elective balance by the percentage of the elective balance and the bid premium. (Chien, page 7, paragraph 52).*
- *Receiving, via a second interface, a percentage number, wherein the percentage number is received from the holder of the elective account balance and represents a percentage of [[an]] the elective balance via the second interface, wherein the percentage of the elective balance is associated with a particular one of a plurality of available redemption categories[[y]]. (Chien: pg 1, pgh 8; pg 7, pgh 52-53)*

Chien does not disclose the remaining limitation. However, Ghouri further suggests:

- *wherein the bid premium is received from one of a plurality of entities competing for access to the elective balance through bid premiums on the redemption categories (Ghouri: pg 2, pgh 22; pg 3, pgh 50; pg 5, pg 65-69)*

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elements cited in Chien with the elements as taught by Ghouri because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately.

Claim 10: Chien/Ghouri suggests the limitation(s) as shown in the rejection of claim 9. Chien further suggests the following limitations:

- *providing a third interface to a second bid device across the communication network (Chien, page 2, paragraph 13);*

- *receiving a second bid premium from the second bid device, wherein the second bid premium is associated with a second redemption category* (Chien, page 2, paragraph 13);
- *receiving a second percentage number, wherein the second percentage number represents a second percentage of the elective balance from the redemption device, wherein the second percentage of the elective balance is associated with the second redemption category.* (Chien: pg 1, pgh 8; pg 7, pgh 52-53)

Claim 11: Chien/Ghouri suggests the limitation(s) as shown in the rejection of claim 10. Chien further suggests the following:

- *calculating a second redemption amount by multiplying the elective balance by the second percentage of the elective balance and the second bid premium* (Chien, page 7, paragraph 52).

Claim 12: Chien/Ghouri suggests the limitation(s) as shown in the rejection of claim 9. Chien further suggests the following:

- *allocating a remaining portion of the elective balance to cash.* (Chien, page 2, paragraph 15).

Claim 13: Chien/Ghouri suggests the limitation(s) as shown in the rejection of claim 9. Chien further suggests the following limitation:

- *the particular redemption category is selected from a group consisting of: cash, a retail outlet, vacation time, additional sick days, and a service provider* (Chien, page 6, paragraph 50).

Claim 14: Chien suggests the following limitation(s):

- *providing an identification interface to a redemption device across a communication network* (Chien, pages 6-7, paragraph 50);
- *receiving an identification via the identification interface, wherein the identification indicates an elective account* (Chien, pages 6-7, paragraphs 50-51);

- *accessing a balance associated with the elective account* (Chien, page 7, paragraph 51);
- *providing an account interface including the balance to the redemption device via the communication network* (Chien, page 7, paragraph 51); and
- *receiving an allocation selection from the redemption device, wherein the allocation selection indicates an amount of the balance to be associated with a particular one of a plurality of available redemption categories* (Chien, page 7, paragraph 52).
- *calculating a redemption amount based at least in part on the bid premium* (Chien: pg 2, pg 11-13)

Chien does not explicitly teach the limitation below. However, Ghouri suggests:

- *providing a bid premium interface to a bid device via the communication network, wherein the bid premium interface comprises bid premiums of [[a]] the plurality of available redemption categories; receiving a bid premium from the bid device, wherein the bid premium is associated with the particular redemption category;* (Ghouri: pg 5, pg 65-69)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elements cited in Chien with the elements as taught by Ghouri because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately.

Claim 15: Chien/Ghouri suggests the limitation(s) as shown in the rejection of claim 14. Chien further suggests the following:

- *associating the amount of the balance with the particular redemption category* (Chien, page 7, paragraph 51); and
- *updating the account interface to indicate the amount of the balance associated with the particular redemption category* (Chien, page 7, paragraph 52).

Art Unit: 3691

Claim 16: Chien/Ghouri suggests the limitation(s) as shown in the rejection of claim 15. Chien further suggests the following:

- *particular the redemption category is selected from a group consisting of: cash, a retail outlet, vacation time, additional sick days, and a service provider* (Chien, page 6, paragraph 50).

Claim 17: Chien/Ghouri suggests the limitation(s) as shown in the rejection of claim 15. Chien further suggests the following:

- *allocating a remaining portion of the balance to cash* (Chien, page 3, paragraph 15); and
- *the particular redemption category is selected from a group consisting of: a retail outlet, vacation time, additional sick days, and a service provider* (Chien, page 6, paragraph 50).

Claim 19: Chien/Ghouri suggests the limitation(s) as shown in the rejection of claim 14. Chien further suggests the following:

- *wherein the amount of the balance is a percentage of the balance* (Chien, page 7, paragraph 52), and
- *wherein calculating the redemption amount comprises: multiplying the balance by the percentage of the balance and the bid premium* (Chien, page 7, paragraph 52).

Claim 20: Chien/Ghouri suggests the limitation(s) as shown in the rejection of claim 14. Chien further suggests the following:

- *providing a second bid premium interface to a second bid device via the communication network* (Chien, page 2, paragraph 13);
- *receiving a second bid premium from the second bid device, wherein the second bid premium is associated with a second redemption category* (Chien, page 2, paragraph 13); and

- *receiving a second allocation selection from the redemption device, wherein the second allocation selection indicates a second amount of the balance to be associated with the second redemption category* (Chien, page 7, paragraph 52).

Claim 21: Chien/Ghouri suggests the limitation(s) as shown in the rejection of claim 20. Chien further suggests the following:

- *calculating a second redemption amount based at least in part on the balance, the second bid premium, and the second allocation selection* (Chien, page 7, paragraph 52).

Conclusion

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event of a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **John Preston** whose telephone number is **571.270.3918**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **ALEXANDER KALINOWSKI** can be reached at **571.272.6771**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see [<http://portal.uspto.gov/external/portal/pair>](http://portal.uspto.gov/external/portal/pair). Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

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/John O Preston/
Examiner, Art Unit 3691
August 11, 2009
/Alexander Kalinowski/

Supervisory Patent Examiner, Art Unit 3691